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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,666	02/11/2004	Tushar Patel	101896-0233	3475

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EXAMINER	
PELLEGRINO, BRIAN E	
ART UNIT	**PAPER NUMBER**
3738	
MAIL DATE	**DELIVERY MODE**
06/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/776,666	PATEL ET AL.	
	Examiner	Art Unit	
	Brian E. Pellegrino	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 March 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-29,31-44,46-54 and 86-93* is/are pending in the application.

4a) Of the above claim(s) *25,29,32,39-44,47 and 49-54* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-7,11-23,26-28,31,33,36-38,46,48 and 86-93* is/are rejected.

7)☒ Claim(s) *8-10,24,34 and 35* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,3,14,17,18,26,27 are rejected under 35 U.S.C. 102(b) as being anticipated by Asher et al. (4773402). Fig. 1 shows an elongate support member with first and second arms **28**,**29** coupled to the support. Fig. 4 shows the elongate support member **58** being curved. The arms are fully capable of sliding along arcuate portions **55**,**56** of the elongate member. Each of the arms has a guide member **36**,**37** respectively mated at a distal end of the arms. Each guide member has at least two pathways (**40**,**41** and **44**,**45**) respectively that is fully capable of being aligned with a bore of an implant. It can be construed that the arms are mated to proximal portions **30**,**31** of the guide members.

Claims 26,28,31,33 are rejected under 35 U.S.C. 102(b) as being anticipated by Kluger (4733657). Fig. 1 shows an adjustable guide member having a first member with an elongate support **4** and a first arm **11** mated to one end and extends transverse to the support member and includes a guide member **9** at a distal end of the arm. It can also be seen there is a second arm **5** with a first end adapted to slidably mate with the elongate support member and has an adjustment mechanism **6** to allow sliding movement along the support member. The second arm also has a second guide member at its distal end. It can also be seen the distal portion of the arms extend at an

angle with respect to the proximal portion. The guide members have a hollow pathway forming a barrel extending transverse to arms capable of receiving a tool. Each guide member has proximal and distal portions with opposed first 8 and second **13** pathways respectively to receive a pin. Since the pin is cylindrical the sidewalls of the pathways have two semi-cylindrical sidewalls.

Claims 1-7,11-13,15-23,26,28,31,36-38,48,86-93 are rejected under 35 U.S.C. 102(b) as being anticipated by Coates et al. (5423826). Coates discloses (Fig. 17) a guide device for use with a spinal fixation plate with the device having two movable arms **151,152** and first and second guide members **157** coupled at the distal end of the arms. It can be seen there are cutout portions between notches **161** or tabs or C-shaped hooks in the guide member to receive the plate and oppose each other. Fig. 16 shows the guide member **157** includes first and second pathways **158**. It can be construed that rod **155** is an elongate support member and extends transverse to the arms. Additionally, the arms have a distal portion that is at an angle to the proximal portion (Figure 20). Each guide member (157) comprises a housing with opposed first and second pathways (Figure 16) where the housing or guide member contains a lumen sleeve (180) which has a rounded tip extends through the barrel into the rounded recess of the accompanying plate. Each pathway in the guide is in communication with each other via a cut out at a distal portion formed in the housing between the first and second pathways (Figure 16) where the cut out portion extends from the housing where the pathways (158) are in communication through the body of the guide. The support member (155) has adjustment knob (154), which allows either arm to move along the

adjustment threads of the lockable support member (column 13 lines 50-67). The examiner is interpreting the claimed elements "slidable" in this way: movement of elements along a surface: Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974). See also *In re Morris*, Fed. Cir. 1997 127 F3d 1048, 1054,1055. Thus, since the threaded elements move along each other's surface, they must be slidably movable.

Response to Arguments

Applicant's arguments filed 3/29/07 have been fully considered but they are not persuasive. Applicant argues that the Asher device does not allow a distance between the first and second arms to be adjusted as a result of slidable movement of the arms along the support member. Applicant admits in the response that the Asher device does have the arms slidably movable along the support member. However, the Applicant failed to describe what is different in the Applicant's structure to permit the adjustability. It should be noted that the recitation of the distance between the arms allowed to be adjusted is indefinite, in that it is merely functional language not supported by a recitation in the claim with sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1992 C.D. 172; 388 O.G. 279.

With regards to the Kluger reference, Applicant argues that first and second pathways of the guide members are aligned along a continuous bore. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., different bores in

offset or unaligned positions) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is well known in the spinal art that there are plates that have bent portions with two different bores to hold a bone screw therein that are aligned. The claims do not exclude bores that can be aligned.

With respect to the comments about the rejection over the Coates reference, it should be noted that Applicant's assessment of the arms "rotating" about the rod appears to be mistaken. Applicant states the arm and locking rod rotate relative to one another, which is impossible since the arm basically pivots about the axis **160** with movement perpendicular to the axis. If the arm was to rotate about the rod this movement would be parallel to the axis and that is not possible since the arm is on a pivot. Clearly the arms do not swing to rotate about the locking rod. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the elongate support having a smooth surface) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus the fact that the surface of Coates' device is threaded to allow movement of the arms relative to one another is irrelevant since Applicant has not claimed any surface structure to distinguish over the prior art.

Allowable Subject Matter

Claims 8-10,24,34,35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on Monday-Friday from 8:30am to 5pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BRIAN E. PELLEGRINO
PRIMARY EXAMINER